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|--|-------------|----------------------|-------------------------|------------------|
| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
| 09/517,163   | 04/05/2000  | Sadahiko Hinoue      | 1247-0424P-SP           | 6242             |
| 7590   | 10/27/2003  |                      | EXAMINER                |                  |
| Birch Stewart Kolaasch & Birch LLP<br>P O Box 747<br>Falls Church, VA 22040-0747 |             |                      | HESSELTINE, RYAN J      |                  |
|  |             |                      | ART UNIT                | PAPER NUMBER     |
|  |             |                      | 2623                    |                  |
|  |             |                      | DATE MAILED: 10/27/2003 |                  |

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                   |               |  |
|------------------------------|-------------------|---------------|--|
| <b>Office Action Summary</b> | Application No.   | Applicant(s)  |  |
|                              | 09/517,163        | HINOUE ET AL. |  |
|                              | Examiner          | Art Unit      |  |
|                              | Ryan J Hesseltine | 2623          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 29 August 2003.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-4 and 6-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 and 6-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Applicant's arguments, see page 3, first paragraph, filed August 29, 2003, with respect to the rejection(s) of claim(s) 1-4, 11-13, 15, and 16 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Fernando et al. (USPN 6,193,152). The examiner believes that adding a limitation to claim 1 in reference to the fingerprint reading and the secret number acquiring such as "concurrently," "simultaneously," "at the same time," "contemporaneously," or the like, the claim could be in condition for allowance (subject to further search).
2. Applicant's arguments filed with respect to Angelo and Shieh have been fully considered but they are not persuasive.
3. On page 4, first paragraph, applicant states with respect to Angelo, "Applicants submit that just because there is a match in plain text doesn't necessarily mean that there is a match in fingerprints." The examiner respectfully disagrees. Angelo teaches that as an alternative to a memorized value (password), the plain text password could be generated with the aid of biometrics, e.g. a scanned fingerprint (column 7, line 26-33). The examiner understands that the applicant is relying on the fact that the password that is created from the scanned fingerprint is not compared to another fingerprint; rather, it is compared to a plain text password. The examiner agrees with this assertion, however, it is believed that this is inconsequential since the

claimed feature of operating a power source if there is a match is explicitly disclosed. The fact that the password is created from a fingerprint attests to the uniqueness of the password, therefore, since fingerprints and passwords are related in the art, they are seen here as equally functional.

4. On page 6, paragraph 4, applicant states with respect to Shieh, "Applicants maintain that Shieh fails to disclose execution level associated with a user and execution level of a menu area (See Figures 15 and 17 of the present invention)." The examiner respectfully disagrees. Shieh clearly discloses a method, apparatus, and article of manufacture that directs a computer system, having at least a processor, memory, and touch screen, to create a virtual pointing device on the touch screen for *executing* commands (emphasis added; column 2, line 18-22) and repeatedly discloses the usage of menus (column 3, line 15-23; column 5, line 13-18 and 30-32; column 6, line 7-12). It is unclear exactly what applicant's arguments are to this affect, but the examiner still believes the claimed limitations are met.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 11-13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick et al. (USPN 5,420,936, previously cited), hereafter Fitzpatrick, in view of Fernando et al. (USPN 6,193,152, newly cited), hereafter Fernando.

7. Regarding claim 1, Fitzpatrick discloses an information processing apparatus comprising: fingerprint verification means for verifying a fingerprint read from a fingerprint reading surface against previously stored fingerprints of authorized users (column 3, line 52-65), the information processing apparatus further comprising: display means having a display surface with orthogonal coordinates set thereon (figure 3, element 50); coordinate designating means for designating coordinates related to fingerprint reading on the display surface (column 4, line 3-10); and control means (84) for controlling an operation based on designated coordinates (column 4, line 10-26).

8. Fitzpatrick discloses that coordinates designated by the user on the touch screen in order to access data or programs identified as A, B, C, D, and E (column 3, line 37-57), but does not explicitly disclose that the designated coordinates indicate secret numbers to be verified. Fernando discloses a modular signature and data-capture system and point of transaction payment and reward system including secret number (personal identification number-PIN) acquiring means (PIN entry unit 190 with keypad 200) for acquiring a secret number (PIN) as well as another accessory unit including a fingerprint unit (210) having a screen against which a user's thumb (or finger) is pressed to make a print (column 4, line 48-62); secret number (PIN) identifying means for verifying the acquired secret number against a previously stored secret number, and control means for controlling an operation (if PIN matches, transaction can go forth) based on a result of the secret number verification (column 4, line 7-20). Fernando also discloses that the PIN may be entered via the virtual keypad (420) provided over LCD 50 (Figure 3; column 11, line 28-35) including an analog-to-digital (A/D) interface which converts the analog pen position to the high resolution x- and y-axis coordinates of touch pad (50A), as is

well known in the art (column 5, line 59-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain both fingerprint data and a secret number (PIN) as taught by Fernando in order to provide security beyond that associated with PIN identification since PINs can easily be lost or compromised (column 1, line 52-57) and to provide a product and system that can interface with a variety of input/output and other peripheral device such as a fingerprint reader (column 2, line 7-22).

9. Regarding claim 2, Fitzpatrick discloses that the display surface and the fingerprint reading surface are one and the same (column 3, line 52-57).

10. Regarding claim 3, Fitzpatrick discloses that the fingerprint reading surface is formed on the coordinate designating means (column 4, line 3-10).

11. Regarding claim 4, Fitzpatrick discloses that the control means activates the fingerprint verification means when specific coordinates are designated (column 4, line 16-26).

12. Regarding claim 11, Fitzpatrick discloses that the information processing apparatus further comprises: icon setting means for setting an icon associated with an application (column 4, line 10-14); and icon designation judging means for judging whether the set icon is designated or not, based on designated coordinates (column 4, line 3-10), wherein when the icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means reads out only data of a user having the matching fingerprint in an application associated with the designated icon and causes the data to be displayed (column 4, line 14-26).

13. Regarding claim 12, Fitzpatrick discloses that when an icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means initiates an

application associated with a user having the matching fingerprint among applications previously set for the respective authorized users ("per-icon" access table 76, column 4, line 18-26).

14. Regarding claim 13, Fitzpatrick discloses that the respective icons are associated with files for the respective authorized users; and when an icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means opens only a file (program/data) of a user having the matching fingerprint out of files associated with the designated icon (column 4, line 18-26).

15. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Fernando as applied to claim 1 above, and further in view of Matsumura (USPN 5,493,621, previously cited). Neither Fitzpatrick nor Fernando discloses that the fingerprint verification means is activated when the secret numbers match each other. Matsumura discloses a fingerprint identification system and method wherein the control means activates the fingerprint verification means when an ID number or password matches each other (column 11, line 44-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to activate the finger verification when the secret numbers match as taught by Matsumura in order to permit high-speed matching of fingerprints by reducing the time it takes to compare fingerprints since a user's fingerprint can be compared with a smaller subset of prints (column 11, line 48-54).

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Fernando as applied to claim 1 above, and further in view of Angelo (USPN 5,887,131,

previously cited). Neither Fitzpatrick nor Fernando discloses operation of a power source when there is a fingerprint match. Angelo discloses an access control method for a computer system wherein a control means controls the operation of a power source of the information processing apparatus (column 8, line 7-34) when there is a match in plain text passwords generated from a scanned fingerprint (column 7, line 26-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to operate a power source when there is a fingerprint/password match as taught by Angelo in order to prevent repeated attempts to gain unauthorized access to the system (column 3, line 10-20).

17. Claims 8-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Fernando as applied to claim 1 above, and further in view of Shieh (USPN 5,874,948, cited on applicant's IDS).
18. Regarding claim 8, neither Fitzpatrick nor Fernando discloses reading an operating condition associated with each user. Shieh discloses when there is a match as a result of the verification of the read fingerprint against the previously stored fingerprints, the control means reads out an operation condition associated with an authorized user having the matching fingerprint from among operation conditions previously set for the authorized users and sets the condition (column 4, line 28-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to read an operating condition associated with each user as taught by Shieh in order to allow users to customize their working environment (column 4, line 28-33).

19. Regarding claim 9, neither Fitzpatrick nor Fernando expressly discloses that all fingers on both hands can be verified. Shieh discloses that the fingerprint verification means is capable of verifying fingerprints of all fingers of both hands (column 3, line 55-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to verify all fingers of both hands as taught by Shieh in order to associate commands with each identifying feature (column 5, line 10-18).

20. Regarding claim 10, neither Fitzpatrick nor Fernando discloses associating a command with each finger of the user. Shieh discloses that when the fingerprints of the respective fingers match the previously stored ones, the control means reads out a command associated with each finger of the user having the matching fingerprints, from among commands previously registered for the respective fingers of the authorized user and executes the commands (figure 2; column 5, line 1-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to associate commands with each finger as taught by Shieh in order to give the user shortcut functions at their fingertips, and to allow further customization (column 4, line 28-33; column 5, line 10-18).

21. Regarding claim 14, neither Fitzpatrick nor Fernando expressly discloses the use of menus. Shieh discloses that the information processing apparatus which creates a virtual pointing device on a touch screen for executing commands (column 2, line 18-22) further comprises: menu (e.g. default menu 262, main menu 600) execution level area setting means for setting an area associated with an execution level of a menu (column 5, line 10-18; column 6, line 7-12); and menu execution level area designation judging means for judging based on designated coordinates (initiate display of pull-down menu, select object within menu) whether a

set menu execution level area is designated or not (column 3, line 15-23), wherein when a menu execution level area is designated and there is a match in fingerprint, the control means executes a menu at an execution level associated with an authorized user having the matching fingerprint among execution levels previously set for the respective users (column 4, line 28-42), as well as an execution level of the designated menu execution level area (column 5, line 30-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the use of menus as taught by Shieh in order to allow the added functionality of a plurality of functions hidden in a drop down menu or the like (column 3, line 15-23).

22. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Fernando as applied to claim 1 above, and further in view of Mori et al. (USPN 5,040,142, cited on applicant's IDS), hereafter Mori.
23. Regarding claim 15, neither Fitzpatrick nor Fernando discloses the processing of a document having a seal box. Mori discloses that a document having a seal box (window 145) is displayed on the display means (column 5, line 1-19); and when detected coordinates are coordinates of the seal box (column 4, line 45-47), the control means affixes an approval seal in the seal box of the document, the information processing apparatus further comprising: communication means for communicating an approval-seal affixed document (column 4, line 53-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to process a document having a seal box as taught by Mori in order to securely process shared documents and allow for approval/review of the documents (column 3, line 49-65).

24. Regarding claim 16, neither Fitzpatrick nor Fernando discloses the processing of a document having a seal box utilizing approval request processing. Mori discloses that a document having a seal box is displayed on the display means; and when detected coordinates are coordinates of the seal box, the control means affixes an approval seal in the seal box of the document (see discussion of claim 15 above), the information processing apparatus further comprising: approval request processing means for subjecting an approval-seal affixed document to an approval request processing (column 3, line 66 to column 4, line 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to process a document having a seal box using approval request processing as taught by Mori in order to securely process shared documents and allow for the documents to be reviewed/approved by a plurality of users (column 2, line 22-28).

### *Conclusion*

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,193,153 to Lambert discloses a method and apparatus for non-intrusive biometric capture. USPN 5,978,495 to Thomopoulos et al. discloses a method and apparatus for accurate determination of the identity of human beings using an integrated apparatus. USPN 6,185,685 to Morgan et al. discloses a security method and system for persistent storage and communications on computer network systems. USPN 6,078,848 to Bernstein et al. discloses a browser kiosk system including a touch screen to receive a password and a serial input device such as a fingerprint scanner. USPN 6,035,406 to Moussa et al. discloses a plurality-factor security system using both a password and a physical token or biometric. USPN 6,111,977 to Scott et al. discloses a hand-held fingerprint recognition and transmission device. USPN

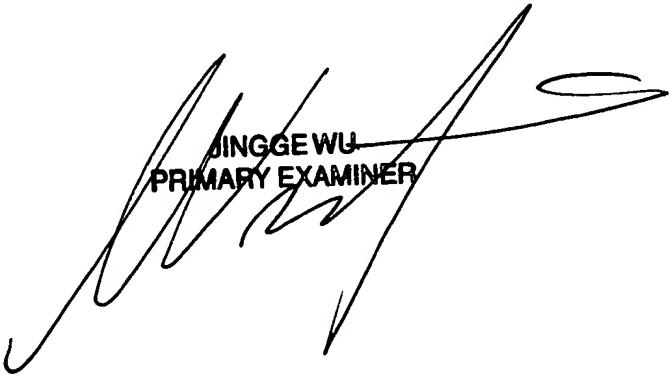
5,970,146 to McCall et al. discloses a data encrypted touch screen. USPN 5,768,386 to Yokomoto et al. discloses a method and system for encrypting input from a touch screen. USPN 6,476,797 to Kurihara et al. discloses a display for acquiring a fingerprint and a visible keying section displayed on screen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

rjh  
October 17, 2003

  
JINGGE WU  
PRIMARY EXAMINER